

REMARKS

Reconsideration and allowance of the subject application in view of the following remarks is respectfully requested. Entry of this Amendment Under Rule 116 is merited as it raises no new issues and requires no further search.

Claims 14-24 remain pending.

The Examiner appears to have erroneously copied a portion of another Office Action into the present Office Action at paragraph 1 as only claims 14-24 are pending in the present application. Correction is requested.

A rejection based on 35 U.S.C. §102 requires every element of the claim to be included in the reference, either directly or inherently. The Examiner has failed to identify all elements of claim 14 as anticipated by Mantha et al. (U.S. Patent 6,163,779). There are at least two reasons claim 14 is patentable over Mantha.

First, Mantha fails to disclose connecting to a user interface a portable memory where the address is stored. Mantha at column 12, lines 55-65, discloses only that the described method of saving a web page to a local hard drive to enable client-side browsing may be stored in another computer memory. Mantha states that "[t]he present invention may be implemented as part of the browser application or as a separate downloaded plug-in. . . . the set of instructions may be stored in another computer memory, for example, in a hard disk drive, or in a removable memory." Mantha at column 12, lines 57-64 (emphasis added). Mantha does not disclose, and the Examiner has failed to identify any location in Mantha disclosing, connecting to a user interface a portable memory where the address is stored.

Second, Mantha fails to disclose causing the user interface to record on the portable memory data indicative of a given point navigated to in the content. Mantha at column 8 discloses saving a web page and not data indicative of a given point in the content. Mantha saves a copy of a web page, "the user accessing a Web page to be copied" and "the title of the page together with a 'Category' in which the page will be saved. By saving pages in one or more Categories, the copied pages are more easily

located for subsequent retrieval." Mantha does not disclose saving data corresponding to a point in a web page at which content consumption ceased. Instead, Mantha saves the entirety of the content accessed, i.e., Mantha saves a copy of the entire web page without recording the location in the web page to which the user has navigated. Mantha fails to record data indicative of a given point navigated to in the content as required by claim 14. Further, as described above in connection with the first point, Mantha does not disclose a portable memory where the address is stored.

Third, Mantha fails to disclose navigating directly to the aforesaid point of the content as stored on the portable memory. Mantha at columns 8-12 discloses saving a copy of a web page; however, as described with respect to the second point above, Mantha fails to disclose recording data indicative of a given point navigated to in the content. As described by Mantha, the user retrieves the entirety of the saved copy of the content without navigating directly to the given point previously navigated to in the content, i.e., "[w]hen the user desires to retrieve the copied page, a link to the pointer is activated. The saved page comes up." Mantha at column 12, lines 32-34.

For each of the above reasons, Mantha fails to anticipate the claimed subject matter of claim 14 and the rejection should be withdrawn.

Claim 15 depends from claim 14 and is patentable over Mantha for at least the reasons advanced above with respect to claim 14. Further, Mantha fails to disclose the data includes an indication of the point in the text where a user stopped reading as claimed in claim 15. As described above with respect to claim 14, Mantha fails to disclose recording where the user stopped reading. In contrast, Mantha discloses saving only a copy of a web page. For each of the above reasons, Mantha fails to anticipate the claimed subject matter of claim 15 and the rejection should be withdrawn.

Claim 16 depends from claim 14 and is patentable over Mantha for at least the reasons advanced above with respect to claim 14. Further, Mantha fails to disclose the data includes an indication of the point in the music where a user stopped listening. Mantha at column 9, lines 45-65 discloses only the saving of an embedded object such as an image file, audio file, an animation, and/or a video as part of the saving of a copy of a web page. There is no disclosure of data including an indication of the point in the

music where a user stopped listening being stored. For each of the above reasons, Mantha fails to anticipate the claimed subject matter of claim 16 and the rejection should be withdrawn.

Claim 17 depends from claim 14 and is patentable over Mantha for at least the reasons advanced above with respect to claim 14 and the rejection should be withdrawn.

Mantha fails to disclose all elements of claim 18, either directly or inherently, for reasons similar to the reasons advanced above with respect to claim 14. For at least these reasons, the rejection of claim 18 should be withdrawn.

Claims 19-20 and 24 depend, either directly or indirectly, from claim 18, include further important limitations, and are patentable over Mantha for at least the reasons advanced above with respect to claim 18. The rejection of claims 19-20 and 24 should be withdrawn.

Claim 21 is patentable over Mantha for at least the reasons advanced above with respect to claim 18 from which claim 20 depends. Further, as the Examiner admits, Mantha fails to teach the limitations of claim 21.

The Examiner asserts that it is old and well known in the art to format content according to user capabilities. The Examiner is reminded that reliance on common knowledge in the art or "well known" prior art is appropriate only for limited circumstances. The Examiner is referred to MPEP §2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art for additional information. "Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While 'official notice' may be relied on, these circumstances should be rare when an application is under final rejection." MPEP 2144.03 A. Any facts noticed using official notice should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner. See MPEP §2144.03 E.

Additionally, the Examiner has failed to provide any basis for his reasoning nor has the Examiner provided specific factual findings predicated on sound technical and

scientific reasoning to support his conclusion of common knowledge. See MPEP §2144.03 B.

The Examiner's assertion of official notice is hereby traversed and the Examiner is requested to provide documentary evidence in the record in support of the Examiner's assertion as the Examiner has failed identify a reference disclosing even the subject matter of recording on a portable memory data indicative of a given point navigated to in the content.

Further, applicant fails to understand, especially as the Examiner's rationale has not been presented, why a person of ordinary skill in the art at the time of the invention would be motivated to modify Mantha to specify the formatting of content according to client capabilities. That is, the Examiner has failed to make out a prima face case of obviousness. The Examiner relies on the specification of the present application in stating that a person of ordinary skill would be motivated to modify Mantha in order to provide content in accordance with preferences of the client. The Examiner has failed to identify a teaching or suggestion for making the asserted modification of Mantha. The Examiner appears to have improperly applied hindsight reasoning based on the present invention to make the asserted modification.

A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. See MPEP 2143.01 quoting Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The Office Action merely stated that the reference can be modified, which Appellants contend to the contrary, and does not state any desirability for making the modification. In other words, the Office Action failed to supply any objective reasons to modify the applied reference.

In accordance with MPEP §2143.01 and Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999), the Examiner was requested to identify a teaching, suggestion, or motivation in either reference or to provide an affidavit of facts within the personal knowledge of the Examiner per MPEP §2144.03 providing a motivation or suggestion to one of ordinary skill in the art to make the argued

combination. The Examiner has neither identified any teaching in Mantha motivating or suggesting the asserted combination to a person of ordinary skill in the art nor provided an affidavit because there is no teaching to be found.

"When an obviousness determination is based on multiple prior art references, there must be a showing of some 'teaching, suggestion, or reason' to combine the references." Winner International Royalty Corp. v. Wang, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000). The Examiner has failed to make such a showing supporting the applied combination of references and therefore the applied combination of references is improper. The Examiner is in error for any of the above reasons and has not made out a prima facie case of obviousness, and the rejection of claim 21 should be withdrawn.

Claims 22 depends from claim 21, includes further important limitations, and is patentable over Mantha for at least the reasons advanced above with respect to claim 21. The rejection of claim 22 should be withdrawn.

Claim 23 is patentable over Mantha for at least the reasons advanced above with respect to claim 21 from which claim 23 depends and the rejection should be withdrawn. All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

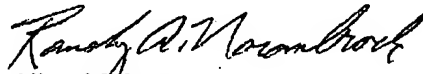
Early issuance of a Notice of Allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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